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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,485	07/30/2001	Ulrich Gerber	003780-060	8847

7590 10/04/2004  
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EXAMINER

OH, TAYLOR V

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/916,485

Applicant(s)

GERBER ET AL.

Examiner

Taylor Victor Oh

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 19-24 is/are pending in the application.
- 4a) Of the above claim(s) 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 19-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Final Rejection***

**The Status of Claims**

Claims 1-17 and 19-24 are pending.

Claim 9 has been withdrawn.

Claim 18 has been canceled.

Claims 1-8 ,10-17, 20-22, and 24 have been rejected.

**Claim Rejections-35 USC 112**

1. Applicants' argument filed 6/23/2004 have been fully considered but they are not persuasive.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The rejection of Claims 1-8 ,10-17, 19-24 under 35 USC 112, second paragraph, maintained due to the failure to modify those claims in the amendment.

**Claim Rejections-35 USC 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Rejection of Claims 1-8, 10-17, and 22 under 35 U.S.C. 102(b) as being anticipated clearly by Kawai et al (JP10330470) has been withdrawn due to the modification made in the claims and applicants' convincing argument.

The rejection of Claims 1-8 and 10-17, and 22 under 35 U.S.C. 102(b) as being anticipated clearly by Kawai et al (JP10330470) has been withdrawn due to the modification made in the claims and applicants' convincing argument on 6/23/04.

### **Applicants' Argument**

1. Various substituents, R<sub>1</sub>, R<sub>2</sub>, R<sub>3</sub>, R<sub>4</sub>, and R<sub>5</sub> are defined in the claim 1 and disclosed in the specification ; for example, those ranges for R<sub>4</sub>, and R<sub>5</sub> are listed (see page 7, line 20 to page 8 ,line 1): from ethylene glycol to decamethylene glycol and dipentaerythritol having 10 carbon atoms;
2. The use of "comprises" is intended to encompass mixtures of compounds and single compounds; and
3. Applicants' polyester polyols are prepared in a two-step process in which a half-ester of a hydroxy-containing acid or ester and a cyclo-aliphatic dicarboxylic acid or anhydride is reacted first and then reacted with a polyhydroxy compound ,whereas the prior art teaches a

Art Unit: 1625

polyestewr polyol prepare from castor oil, terephthalic acid and ethylene glycol in a one-step dehydration process.

First, with respect to the first argument, applicants have added the limitation of carbon atom range for only  $R_1$  and  $R_2$ , but not for  $R_4$ , and  $R_5$ . Claim 1 is directed to the compound claim, which requires clear metes and bounds of the claimed compounds; otherwise, the compound claim still remains vague and indefinite. If Applicant have convinced that those ranges for  $R_4$ , and  $R_5$  are listed on page 7, line 20 to page 8, line 1, please add those to the claim.

Second, with respect to the second argument, the Examiner has noted applicants' argument. However, the use of the term "comprises" for describing "polyester polyols", "cyclic 1,2-dicarboxylic anhydride", and "polyol" is a vague expression because the terminologies of polyester polyols, cyclic 1,2-dicarboxylic anhydride, and polyol indicate that they have the corresponding definite structures whether each of them is singular or plural.

Furthermore, applicants have admitted that the use of "comprises" is intended to encompass mixtures of compounds and single compounds. The examiner recommends to change from "comprises" to "is or are".

Third, with respect to the third argument, the Examiner agrees with applicants' argument.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

Art Unit: 1625

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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myh  
9/28/24

Cecilia Tsang